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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,319	03/06/2002	Tejaswini Hosali	YOR920010754US1	9034

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EXAMINER

WILLETT, STEPHAN F

ART UNIT PAPER NUMBER

2142

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,319

Applicant(s)

HOSALI ET AL.

Examiner

Stephan F. Willett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC 102

1. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Boucher et al. with Patent Number 5,884,246.

1. Regarding claim(s) 1, 18, Boucher teaches translating emails, col. 3, lines 28-38.

Boucher teaches parsing a document to retrieve variable data related to a destination language, col. 11, lines 44-46 such a line items including a destination address as determining “the language into which the message is to be translated by noting the top level domain”, col. 11-12, lines 66-2 and “the translation machine determines the country which is the destination of the translated message by the two letter country indicating top level domain”, col. 12, lines 10-12.

The translation machine parses the destination address to determine the “two letter country”.

Boucher teaches automatically determining if the parsed variable data[subdomain], including the destination address, requires a dynamic task to be selected, col. 10, lines 3-5 and at col. 11, lines 48-51. Boucher teaches based on the parsed data selecting a destination language for the email and attachments, col. 11, lines 60-62; col. 9, line 45. Boucher teaches sending the email in the

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destination language with said variable data, col. 9, lines 31-34 and inherently if translation is not required then transmitting the email in the origin language.

2. Regarding claim(s) 2, 10, 19, Boucher teaches sending emails to two addresses in two different languages col. 13, lines 5-12, and the variable data of at least two destination addresses, col. 13, lines 19-24 wherein the different languages are determined as taught above, col.

12,liknes 10-14.

3. Regarding claim(s) 3-4, 20-21, Boucher teaches verifying the language based on destination country, col. 12, lines 10-14; col. 9, line 42.

4. Regarding claim(s) 5, 15, 22, Boucher teaches verifying the language based on the communication language exchanged, col. 13, lines 47-49.

5. Regarding claim(s) 6, 23, Boucher teaches verifying the language based on the preferred destination address's language, col. 13, lines 3-5.

6. Regarding claim(s) 7, 9, 24, 26, Boucher teaches selecting an English language based default, col. 12, lines 2-3.

7. Regarding claim(s) 8, 25, Boucher teaches verifying the language based on destination country, col. 12, lines 10-14.

8. Regarding claim(s) 11, 27, Boucher teaches sending email based on product and services, col. 7, lines 66-67; col. 12, lines 26-30.

9. Regarding claim(s) 12, 28, Boucher teaches an attachment including a document, col. 9, line 44.

10. Regarding claim(s) 13, 29, Boucher teaches an attachment including a document in a distributable format, col. 9, line 45 and since it is being forwarded is being distributed.

11. Regarding claim(s) 14, 30-31, Boucher teaches parsing a document to retrieve variable data triggered by an inquiry, i.e. to translate, col. 10, lines 46-49.

12. Regarding claim(s) 16-17, 32-33, Boucher teaches translating emails, col. 6, line 7 based on Internet addressing, col. 6, line 16.

Response to Amendment

13. The broad claim language used is interpreted on its face and based on this interpretation the claims have been rejected.

1. The limited structure claimed, without more functional language, reads on the references provided. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

2. Applicant suggests Boucher "does not explain the details of this method", Paper Filed 7/30/05, Page 13, lines 22-23. However, Boucher teaches determining "the language into which the message is to be translated by noting the top level domain", col. 11-12, lines 66-2 and "the translation machine determines the country which is the destination of the translated message by the two letter country indicating top level domain", col. 12, lines 10-12. The translation machine parses the destination address to determine the "two letter country". Thus, Applicant's arguments can not be held as persuasive regarding patentability.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "as explained in the instant specification and the Summary", Paper Dated 7/30/05, Page 14, lines 4-5) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, Applicant's arguments can not be held as persuasive regarding patentability.

1. Applicant suggests "translation to the destination language is not required", Paper Filed 7/30/05, Page 14, lines 13-14 is not taught. "[The] specification, having described the whole, necessarily described the part remaining", In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977), see also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983) and "negative limitations extended to define the invention in terms of what it was not, rather than pointing out the invention", MPEP 2172.05(I). A negative type limitation, that implicitly teaches other related parts remaining, to avoid obvious elements of a reference does not exude novelty of the whole. Here, inherently if the document does not need to be translated then no task is required. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the references is suggested. The other references cited teach numerous other ways to translate emails, thus a close review of them is suggested.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (571)272-3890. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

4.

sfw

October 5, 2005



**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**